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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/942,837 | 08/29/2001 | Shawn R. Gettemy | PALM-3651 | 8549 |
| 7590 04/14/2008 WAGNER, MURABITO & HAO LLP Third Floor Two North Market Street San Jose, CA 95113 | | | EXAMINER PIZZALI, JEFFREY J | |
| | | | ART UNIT 2629 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/942,837

Applicant(s)

GETTEMY ET AL.

Examiner

Jeff Piziali

Art Unit

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 6, 8-11, 13, 15, 17-19, 21, 22, 24, 25 and 29-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8-11, 13, 15, 17-19, 21, 22, 24, 25 and 29-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The use of the trademarks such as "**ELECTRODAG**" (e.g., see Page 10, Lines 14-16), "**E INK**" (e.g., see Page 12, Line 19), and "**BLUETOOTH**" (e.g., see Page 15, Line 11) has been noted in this application. They should be capitalized wherever they appear and be accompanied by the respective generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

2. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Drawings

3. The drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the figures.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3, 6, 8, 9, 11, 15, 17, 18, 22, 24, 25, 29, and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. The term "*flexible thermoplastic film*" in claims 3, 11, and 29 is a relative term which renders the claims indefinite. The term "*flexible*" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In materials science, the amount of deformation an object can be bent, twisted, lengthened or compressed due to a force or stress is called the strain. The instant application is silent on the matter of the minimum value of strain a material may endure before breakage. Absent a definite teaching in the instant claims and specification of what constitutes a "*flexible*" material layer, one having ordinary skill in the art could arguably take the position that flexibility is an inherent characteristic of all solid bodied materials. Much like all liquids have some degree of viscosity -- so too do all solids have some degree of flexibility.

7. The term "*decorative border*" in claims 6, 15, and 22 is a relative term which renders the claims indefinite. The term "*decorative*" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

It would be unclear to an artisan precisely how aesthetically pleasing the border must be before it would qualify as a "**decorative border**." Any cover border inherently serves at least some degree of aesthetic purpose, and would therefore be considered "**decorative**" by an artisan.

8. Claims 8, 17, and 24 recite the limitation "**hidden from view**." There is insufficient antecedent basis for this limitation in the claims. It would be unclear to an artisan precisely what and whose view such a periphery is supposed to be hidden from. A user? The manufacturer? From some random person sitting another room?

9. Claims 9, 18, and 25 recite the limitation "**indentations to indicate button functions**." There is insufficient antecedent basis for this limitation in the claims. It would be unclear to an artisan precisely how "**button functions**" can be "**indicated**" when no "**buttons**" are anywhere claimed. Does any "**indentation**" inherently "**indicate [a] button function**"? Furthermore, it would be unclear to an artisan precisely what claimed elements is meant to provide the "**functions**."

10. Claims 34 is rejected under 35 U.S.C. 112, second paragraph, as being dependent upon a rejected base claim.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1, 3, 6, 8, 9, 35, and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by **Suzuki (US 6,529,188 B1)**.

Regarding claim 1, Suzuki discloses a display assembly [Fig. 12; 480] for an electronic device [i.e., a "portable information terminal"] comprising: a display [Fig. 8; 1]; a digitizer [Fig. 8; 4] disposed above said display (see Column 12, Line 46 - Column 13, Line 49) and for providing an input [Fig. 1A; e.g., "push inputting manipulation" performed via pen 560] to said electronic device in response to a deformation of said digitizer (see Column 8, Lines 40-56); and a cover [Fig. 1A; 4A] disposed above said digitizer [Fig. 1A; 11 and 12] and for enabling said deformation of said digitizer in response to a contact with said cover, wherein said cover overlaps (i.e., *to lie or extend over and cover a part of; to partially extend over; coincide partially or wholly*) a side [e.g., the front viewing side] of said display (see Fig. 12; Column 7, Line 42 - Column 8, Line 67); and wherein said cover [Fig. 1A; 4A] comprises at least one bend [Fig. 1A; the bends at the intersections of regions AR + NR and NR + SL] for enabling said overlapping of said side of said display (see Column 7, Line 42 - Column 8, Line 67).

Regarding claim 3, Suzuki discloses said cover further comprises a flexible thermoplastic film [Fig. 1A; 4A] and a supporting structure [Fig. 1A; 4B] coupled to said flexible thermoplastic film (see Column 10, Lines 46-52).

Regarding claim 6, Suzuki discloses said cover further comprises a decorative border [Fig. 11A; 15 and 20] (see Column 14, Lines 30-54 -- *wherein the border inherently serves an aesthetic purpose*).

Regarding claim 8, Suzuki discloses said digitizer comprises electrical traces and circuits [Fig. 12; 500, 530, 540, 550] along a periphery that are hidden from view by said decorative border (see Figs. 5 and 11A; Column 14, Line 55 - Column 15, Line 17)

Regarding claim 9, Suzuki discloses said cover comprises indentations to indicate button functions (see Fig. 12; Column 14, Line 55 - Column 15, Line 21).

Regarding claim 35, Suzuki discloses said first cover comprises at least one transparent portion [Fig. 1A; 4A] (see Column 13, Line 50 - Column 14, Line 29).

Regarding claim 36, Suzuki discloses said digitizer comprises a resistive digitizer [Fig. 10; 4] (see Column 13, Line 50 - Column 14, Line 29).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 2, 5, 10, 11, 13, 15, 17-19, 21, 22, 24, 25, 29-34, and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Suzuki (US 6,529,188 B1)* in view of *Conroy et al (US 5,686,705 A)*.

Regarding claim 2, Suzuki discloses said digitizer comprises a conductive film made of indium tin oxide [Fig. 5; 11] disposed above a digitizing element [Fig. 5; 22] (see Column 10, Lines 46-52).

However, Conroy does disclose substituting conductive digitizer wires with a conductive polymer composite, such as conductive plastic (see Column 3, Lines 9-30, Column 4, Lines 21-32, Column 5, Line 55 - Column 6, Line 10, and Column 8, Lines 37-40).

Suzuki and Conroy are analogous art, because they are from the shared field of manufacturing electronic touch panel devices. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to use Conroy's conductive polymer in place of Suzuki's conductive film, so as to provide a rugged and reliable electronic device.

Regarding claim 5, Suzuki discloses said digitizer further comprises a plurality of electrodes and traces [Fig. 1A; 11 and 12] operable to register a point of contact when said conductive polymer makes contact with said digitizing element (see Column 7, Line 42 - Column 8, Line 67).

Regarding claim 10, this claim is rejected by the reasoning applied in rejecting claim 1; furthermore, although Suzuki does not expressly disclose a processor coupled to memory;

Conroy does disclose a portable electronic device [Fig. 4; 116] comprising: a processor [Fig. 4; 142]; and a memory [Fig. 4; 145, 147] coupled to said processor (see Column 11, Lines 4-40).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to use Conroy's electronic circuitry with Suzuki's display assembly, so as to provide a rugged and reliable electronic device, as well as to accurately determine a location selected by a user.

Regarding claim 11, this claim is rejected by the reasoning applied in rejecting claim 3.

Regarding claim 13, this claim is rejected by the reasoning applied in rejecting claims 2 and 5; furthermore, Suzuki discloses said cover is operable to deflect under external pressure and cause said conductive polymer to contact said digitizing element and activate said digitizer (see Fig. 1A; Column 7, Line 42 - Column 8, Line 67).

Regarding claim 15, this claim is rejected by the reasoning applied in rejecting claim 6.

Regarding claim 17, this claim is rejected by the reasoning applied in rejecting claim 8.

Regarding claim 18, this claim is rejected by the reasoning applied in rejecting claim 9.

Regarding claim 19, this claim is rejected by the reasoning applied in rejecting claims 1 and 10; furthermore, Suzuki discloses a second cover [Fig. 12; 480] coupled to said first cover,

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wherein said first and second covers enclose said display and said digitizer (see Column 14, Line 55 - Column 15, Line 17).

Regarding claim 21, this claim is rejected by the reasoning applied in rejecting claims 2, 5, and 13.

Regarding claim 22, this claim is rejected by the reasoning applied in rejecting claim 6.

Regarding claim 24, this claim is rejected by the reasoning applied in rejecting claim 8.

Regarding claim 25, this claim is rejected by the reasoning applied in rejecting claim 9.

Regarding claim 29, this claim is rejected by the reasoning applied in rejecting claim 3.

Regarding claim 30, this claim is rejected by the reasoning applied in rejecting claims 2, 5, and 13.

Regarding claim 31, this claim is rejected by the reasoning applied in rejecting claim 5.

Regarding claim 32, Suzuki discloses said first cover comprises at least one transparent portion [Fig. 1A; 4A] (see Column 13, Line 50 - Column 14, Line 29).

Regarding claim 33, Suzuki discloses said digitizer comprises a resistive digitizer [Fig. 10; 4] (see Column 13, Line 50 - Column 14, Line 29).

Regarding claim 34, this claim is rejected by the reasoning applied in rejecting claim 5.

Regarding claim 37, this claim is rejected by the reasoning applied in rejecting claim 19.

Regarding claim 38, this claim is rejected by the reasoning applied in rejecting claim 32.

Regarding claim 39, this claim is rejected by the reasoning applied in rejecting claim 33.

Response to Arguments

15. Applicant's arguments filed 28 January 2008 have been fully considered but they are not persuasive.

The Applicant contends the cited prior art of ***Suzuki (US 6,529,188 B1)*** neglects teaching, "*said cover comprises at least one bend for enabling said overlapping of said side of said display' as recited in independent Claim 1*" (see Page 9 of the Amendment filed 28 January 2008). However, the examiner respectfully disagrees.

Suzuki discloses a cover [Fig. 1A; 4A] comprising at least one bend [Fig. 1A; the bends at the intersections of regions AR + NR and NR + SL] for enabling said overlapping of a side

[e.g., the front viewing side] of a display [Fig. 8; 1] (see Column 7, Line 42 - Column 8, Line 67).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *a touch panel assembly with non-exposed sides and/or a deformation enables a cover to overlap a side of the display* -- see Page 9 of the Amendment filed 28 January 2008) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Applicant contends the cited prior art of **Suzuki (US 6,529,188 B1)** neglects teaching, a "*cover which overlaps a side of said display*" (see Page 9 of the Amendment filed 28 January 2008). However, the examiner respectfully disagrees.

Suzuki discloses a cover [Fig. 1A; 4A] disposed above a digitizer [Fig. 1A; 11 and 12] and for enabling said deformation of said digitizer in response to a contact with said cover, wherein said cover [see Fig. 8; 4A] overlaps (i.e., *to lie or extend over and cover a part of; to partially extend over; coincide partially or wholly*) a side [e.g., the front viewing side] of a display [Fig. 8; 1] (see Column 12, Line 46 - Column 13, Line 49).

The Applicant also contends the cited prior art of *Suzuki (US 6,529,188 B1)* neglects teaching, a "*cover [that] further comprises a decorative border*" (see Page 9 of the Amendment filed 28 January 2008). However, the examiner again respectfully disagrees.

Suzuki discloses said cover further comprises a "*decorative border*" [Fig. 11A; 15 and 20] (see Column 14, Lines 30-54 -- *wherein the border inherently serves an aesthetic purpose*).

The Applicant argues, "*that cited portion of Suzuki (col. 14, lines 30-54) does not use the word 'border'*" (see Page 10 of the Amendment filed 28 January 2008). However, regardless of what Suzuki labels the illustrated regions 15 and 20 in Figure 11A; one having ordinary skill in the art would recognize the regions [Fig. 11A; 15 and 20] to form plural borders (i.e., *parts or edges of a surface or area that forms its outer boundaries*). The regions [Fig. 11A; 15 and 20] inherently form and represent a "*decorative border*" as instantly claimed.

The Applicant also contends the cited prior art of *Suzuki (US 6,529,188 B1)* neglects teaching, a "*said digitizer comprises electrical traces and circuits along a periphery that are hidden from view by said decorative border*" (see Page 11 of the Amendment filed 28 January 2008). However, the examiner again respectfully disagrees.

Suzuki discloses said digitizer comprises electrical traces and circuits [Fig. 12; 500, 530, 540, 550] along a periphery that are hidden from view by said decorative border (see Figs. 5 and 11A; Column 14, Line 55 - Column 15, Line 17 -- *wherein the electrical circuitry is clearly blocked from the view of a user by the laptop computer's housing -- almost any portion of which constituting a "decorative border" as instantly claimed*).

The Applicant also contends the cited prior art of *Suzuki (US 6,529,188 B1)* neglects teaching, a "*said cover comprises indentations to indicate button functions*" (see Page 11 of the Amendment filed 28 January 2008). However, the examiner again respectfully disagrees.

Regarding claim 9, Suzuki discloses said cover comprises indentations to indicate button functions (see Fig. 12; Column 14, Line 55 - Column 15, Line 21).

Suzuki expressly teaches, "*This screen input type liquid crystal display device enables various manipulations including the inputting of information using a keyboard 490, the inputting of various information by pushing, the tracing or the filling in the surface of the touch panel with the input pen 560, the selection of information displayed on the liquid crystal panel, the selection of processing functions and others various manipulations*" (see Column 15, Lines 10-17).

Pushing the surface of Suzuki's touch panel inherently results in indentations. And the selection of information and processing functions via pushing manipulations of the pen upon the touch panel fully reads on the subject matter of *button functionality indications*, as instantly claimed.

By such reasoning rejection of the claims is deemed necessary, proper, and thereby maintained at this time.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Piziali whose telephone number is (571) 272-7678. The examiner can normally be reached on Monday - Friday (6:30AM - 3PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (571) 272-7681. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeff Piziali/
Primary Examiner, Art Unit 2629
8 April 2008